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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,722	02/05/2001	Gordon Michael Wiram	57111-5098	6086

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT PAPER NUMBER

3627

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,722

Applicant(s)

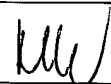
WIRAM, GORDON MICHAEL

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

37 CFR 1.105 Requirement to Provide Information

The examiner gratefully acknowledges the receipt of the information requested in the previous Office Action.

For further clarification, Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Prior to February 5, 2004, did the system have the following elements?

1. A return feature having an equipment information section that prompts for information pertaining to equipment being returned and a payment section;
2. A closing report having a list of all transactions processed for a specified day and including a contract number, a method of payment, an amount received, and an amount refunded;
3. A rental feature which displays the rental rate for equipment identified;
4. A rental agreement produced which includes the terms of the rental transaction and an itemized list of charges.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 31 recites a "computer – server operatively coupled to the internet and configured to include a rental feature and a payment section ...". The original specification and claims show only that the point of sale system as a whole has these features. While page 5 of the specification mentions that communications is carried out via a browser based program located remotely from the server, the functionalities residing on the server machine and client machine were not described (e.g., a "fat" client accessing remote databases and providing functionality locally as opposed to a "skinny" client where functionality is maintained at the server). The specification did not describe the invention in such a way as to reasonably convey to one in the art that the inventor had possession of the claimed invention.

Claim 42 recites a "browser system including a rental feature and a payment section ...". The original specification and claims show only that the point of sale system as a whole has these features, not that they reside with the browser at the client. While page 5 of the specification mentions that communications is carried out via a browser based program located remotely from the server, the functionalities residing on the server machine and client machine were not described (e.g., a "fat" client accessing remote databases and providing functionality locally as opposed to a "skinny"

client where functionality is maintained at the server). The specification did not describe the invention in such a way as to reasonably convey to one in the art that the inventor had possession of the claimed invention.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the reservation feature and the payment section of the point of sale system (cls. 1-12 and 19-29); the transfer feature; the return feature; the reporting feature; the marketing section; the customer information section; the equipment information section; and the credit card payment section must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as

per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-29 and 42-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-29 and 42-52 appear to recite only disembodied software elements, such as the "reservation feature", and data manipulated and produced by the software (such as the credit card information and the reports). Software that is not embedded in a tangible medium is per se non-statutory. It is noted that software recited as residing in a tangible medium (e.g., memory or a hard drive) is considered statutory.

Claim Objections

Claims 2-12 and 19-29 are objected to because of the following informalities: It appears that claims 2-12 are substantially identical to amended claims 19-29. Appropriate correction is required.

It is noted that claims 6, 7, 16, 17, 23 and 24 recite only information included in reports, and are drafted so as to recited elements of the apparatus. Although the

elements are not interpreted as limitations to the apparatus, they will be treated as such below in order to further prosecution.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-20, and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U-Haul reservation system prior to 2/5/2000 in view of Francisco et al (5,875,433)

Prior to 2/5/2000, a PC based Point of Sale system was in use by U-Haul and certain U-Haul dealers. The system was implemented on personal computers and/or computer networks. This PC-based system included a rental feature having a customer information section and a payment section, a reservation feature having a customer information section and an equipment information section, and a payment section, having a cash section, check section and credit card section. The PC-based system further included a transfer feature having an equipment information section, a reporting feature comprising a closing report, a reservation report, an inventory report, an equipment due report and a refund report, as well as a marketing section having a marketing message relating to the moving equipment rental business. In addition, the Pc-based system included a customer information section that stored and recalled

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customer information, as well as an equipment information section that stored and recalled information pertaining to a transaction. It also included a rental feature with a printable rental agreement. The system of U-Haul was not operatively connected to the internet. Francisco shows connecting a point of sale system to the internet. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Uhaul by connecting the POS system to the internet in order to provide for automated tax reporting to the relevant tax authority.

As to claims 6, 7, 23 and 24, U-Haul in view of Francisco et al show all elements except that the closing report shows a contract number, method of payment, amount received and an amount refunded for all transactions for a specified day. However, it is notoriously old and well known in the art to include such information on a closing report. It would have been obvious to one of ordinary skill in the art to do so in order to fully characterize the transactions occurring during that day.

As to claim 14, U-Haul in view of Francisco et al show all elements except displaying a rental rate. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by having it display the rental rate for equipment in order to provide the customer with information needed in making a rental decision.

As to claims 16 and 17, U-Haul in view of Francisco et al show all elements except the rental agreement including the rental terms of the transaction and an itemized list of charges. However, it is notoriously old and well known in the art to provide this information on a rental agreement. It would have been obvious to one of

ordinary skill in the art to provide this information in order to avoid later conflicts and to provide the customer with notice of the terms of the agreement.

Claims 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U-Haul in view of Francisco et al as applied to claims 2 and 19 above, and further in view of the Budget reservation system.

Uhaul in view of the well known art shows all elements except the return feature. The system of Budget shows this feature. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by using the rental return feature of Budget in order to facilitate easy recall of data and return of equipment.

Claims 31, 32, and 34-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U-Haul reservation system prior to 2/5/2000.

Prior to 2/5/2000, a PC based Point of Sale system was in use by U-Haul and certain U-Haul dealers. The system was implemented on personal computers and/or computer networks. This PC-based system included a rental feature having a customer information section and a payment section, a reservation feature having a customer information section and an equipment information section, and a payment section, having a cash section, check section and credit card section. The PC-based system further included a transfer feature having an equipment information section, a reporting feature comprising a closing report, a reservation report, an inventory report, an equipment due report and a refund report, as well as a marketing section having a marketing message relating to the moving equipment rental business. In addition, the

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Pc-based system included a customer information section that stored and recalled customer information, as well as an equipment information section that stored and recalled information pertaining to a transaction. It also included a rental feature with a printable rental agreement. The system of U-Haul does not show that these software features are part of a server. However, it is notoriously old and well known in the art to port a standalone software package to a server for use in a client – server architecture (for example several stand alone income tax preparation programs have been placed on servers and made available via the internet). It would have been obvious to one of ordinary skill in the art to modify the apparatus of U-Haul by placing the functionalities on a server in order to ease software updates to the system.

As to claims 35 and 36, U-Haul in shows all elements except that the closing report shows a contract number, method of payment, amount received and an amount refunded for all transactions for a specified day. However, it is notoriously old and well known in the art to include such information on a closing report. It would have been obvious to one of ordinary skill in the art to do so in order to fully characterize the transactions occurring during that day.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over U-Haul as applied to claim 31 above, and further in view of the Budget reservation system.

Uhaul shows all elements except the return feature. The system of Budget shows this feature. It would have been obvious to one of ordinary skill in the art to

further modify the apparatus of U-Haul by using the rental return feature of Budget in order to facilitate easy recall of data and return of equipment.

It is noted that claim 42 is interpreted as reciting a client browser having the functionalities of the rental feature and the payment section (i.e., reciting a "fat" client).

Claims 42, 43, and 45-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U-Haul reservation system prior to 2/5/2000.

Prior to 2/5/2000, a PC based Point of Sale system was in use by U-Haul and certain U-Haul dealers. The system was implemented on personal computers and/or computer networks. This PC-based system included a rental feature having a customer information section and a payment section, a reservation feature having a customer information section and an equipment information section, and a payment section, having a cash section, check section and credit card section. The PC-based system further included a transfer feature having an equipment information section, a reporting feature comprising a closing report, a reservation report, an inventory report, an equipment due report and a refund report, as well as a marketing section having a marketing message relating to the moving equipment rental business. In addition, the Pc-based system included a customer information section that stored and recalled customer information, as well as an equipment information section that stored and recalled information pertaining to a transaction. It also included a rental feature with a printable rental agreement. The system of U-Haul does not show that these software

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features are resident in the client browser. However, it is notoriously old and well known in the art to provide the software functionalities associated with a standalone system in a "fat" client having a browser interface. It would have been obvious to one of ordinary skill in the art to do so in order to facilitate access to remote shared databases while minimizing the load on the server.

As to claims 46 and 47, U-Haul in shows all elements except that the closing report shows a contract number, method of payment, amount received and an amount refunded for all transactions for a specified day. However, it is notoriously old and well known in the art to include such information on a closing report. It would have been obvious to one of ordinary skill in the art to do so in order to fully characterize the transactions occurring during that day.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over U-Haul as applied to claim 42 above, and further in view of the Budget reservation system. Uhaul shows all elements except the return feature. The system of Budget shows this feature. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by using the rental return feature of Budget in order to facilitate easy recall of data and return of equipment.

Response to Arguments

Applicant's arguments filed 4/15/2004 have been fully considered but they are not persuasive.

Regarding the 35 USC 101 rejection, the examiner agrees that the technological nexus is present since the claims have been amended to recite an operative connection to the internet.

However, while the preamble recites a system (assumed to be an apparatus), the body of the claims appear to recite only disembodied software elements, which are not tangible and which are per se non-statutory. In combination with a computer readable medium, however, so as to be capable of producing a useful, concrete, and tangible result the software elements are statutory. *In re Wamerdam*, 31 USPQ2d 1754 (Fed. Cir. 1994).

Conclusion

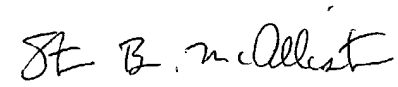
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister